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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,510

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Ronald Vogels

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10/03/2006

TRASK BRITT

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EXAMINER

LI, QIAN JANICE

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,510

Applicant(s)

VOGELS ET AL.

Examiner

Q. Janice Li, M.D.

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The amendment and response filed 7/21/06 have been entered. Claims 1-3 have been amended, and claims 7-10 are newly submitted. Claims 1-10 are under current examination.

Unless otherwise indicated, previous rejections that have been rendered moot in view of the amendment to pending claims or persuasive arguments will not be reiterated. The arguments in 7/21/06 response would be addressed to the extent that they apply to current rejection.

#### ***Claim Rejection***

Claims 4 and 5 are objected to because current numbering is incorrect. Correction is required.

#### ***Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is vague and indefinite because of the claim recitation "normally". It is unclear what condition is considered normally, and thus the metes and bounds of the

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claim is uncertain. Further, the amended "wherein" phrase is confusing, which reads "a sequence encoding...instead comprises a sequence...". It is unclear which word or phrase the "instead" defines, and whether the "sequence normally encoding the tissue tropism domain..." is still present, and thus the metes and bounds of the claim is uncertain.

Claim 7 is vague and indefinite because both fibroblast-like cells and macrophage-like cells encompass a cell type, i.e. "fibroblast-like synoviocytes". It is unclear the difference between the two types of cells, and thus the metes and bounds of the claim is uncertain.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7, 8, 9, 10 are rejected under 35U.S.C. 112 first paragraph, because the specification as originally filed does not describe the invention as now claimed. The original disclosure fails to specify the term "type B synoviocytes, or type A synoviocytes" as now claimed; and the original disclosure fails to teach "said fibroblast-like cell is a fibroblast cell" or "said macrophage-like cell is a macrophage cell". Accordingly, the amendment introduces new matter.

MPEP 2163.02 teaches that "WHENEVER THE ISSUE ARISES, THE FUNDAMENTAL FACTUAL INQUIRY IS WHETHER A CLAIM DEFINES AN INVENTION THAT IS CLEARLY CONVEYED TO THOSE SKILLED IN THE ART AT THE TIME THE APPLICATION WAS FILED...IF A CLAIM IS AMENDED TO

INCLUDE SUBJECT MATTER, LIMITATIONS, OR TERMINOLOGY NOT PRESENT IN THE APPLICATION AS FILED, INVOLVING A DEPARTURE FROM, ADDITION TO, OR DELETION FROM THE DISCLOSURE OF THE APPLICATION AS FILED, THE EXAMINER SHOULD CONCLUDE THAT THE CLAIMED SUBJECT MATTER IS NOT DESCRIBED IN THAT APPLICATION”.

In the instant case, new Claim 7 contains two Markush groups, each comprising

- a). fibroblast-like type B cells, type B synoviocytes, and fibroblast-like synoviocytes; and
- b). fibroblast-like synoviocytes, type A synoviocytes, and macrophage-like type A cells.

Applicant points to paragraph 0007-0008 of the specification for support of the new claim. A closer look of these passages would find there are no teaching regarding these many types of synoviocytes. The passages recite terms such as “macrophage-like type A cells”, or “fibroblast-like type B cells”, but are silent concerning the category of type B synoviocytes or type A synoviocytes, or how to distinguish such from “macrophage-like type A cells”, or “fibroblast-like type B cells”. Thus, the amendment appears to be a departure from or an addition to the disclosure of the application as filed, accordingly, it introduces new matter into the disclosure.

New claim 8 recites, “wherein said fibroblast-like cell is a fibroblast cell”. This contradicts the teaching of the specification as filed. For example, the specification teaches, “The fibroblast-like synoviocytes (“FLS”) are distinguishable from normal fibroblast cells in the subintimal synovium by differential gene expression patterns” (paragraph 0007). The specification fails to explicitly define the term “fibroblast-like” or “macrophge-like”, given the common sense, the whole point of naming fibroblast/macrophage-like implicitly indicate that the types of cells are not fibroblast/macrophage, they only share

certain features of fibroblast/macrophage. Thus, the amendment appears to be a departure from or an addition to the disclosure of the application as filed, accordingly, it introduces new matter into the disclosure.

For reasons set forth above, the amendment filed 7/21/06 is objected to under 35 U.S.C. §132 because it introduces new matter into the disclosure. 35 U.S.C. §132 states that no amendment shall introduce new matter into the disclosure of the invention. Applicant is required to cancel the new matter in the reply to this Office Action. Alternatively, Applicant are invited to specifically point out where in the specification the support can be found for the amendment made to the disclosure.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 stand or are newly rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S.

Patent No. 6,869,936, for reasons of record and following.

Applicant indicated "a terminal disclaimer is filed herewith".

However, such a terminal disclaimer is not currently on record.

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Q. Janice Li** whose telephone number is 571-272-0730. The examiner can normally be reached on 9:30 am - 7 p.m., Monday through Friday, except every other Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Dave T. Nguyen** can be reached on 571-272-0731. The **fax** numbers for the organization where this application or proceeding is assigned are **571-273-8300**.

Any inquiry of formal matters can be directed to the patent analyst, **William Phillips**, whose telephone number is (571) 272-0548.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is **(866) 217-9197**. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

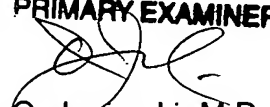


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**Q. JANICE LI, M.D.  
PRIMARY EXAMINER**



Q. Janice Li, M.D.  
Primary Examiner  
Art Unit 1633

*QJL*  
September 28, 2006